Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GERALD J. JULIEN

Appeal No. 2002-0605
Application No. 09/096,542

ON BRIEF

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 5 to 7, 9 and 11 to 17. Claims 4, 8, 10 and 18 to 20, the only other claims pending in this application, have been withdrawn from consideration.

We REVERSE.

BACKGROUND

The appellant's invention relates to impact absorbers to protect humans, animals, equipment and cargo from injury or damage during transportation or other movement in which there is danger of destructive impact with external objects (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Eshelman	4,254,978	Mar. 10, 1981
Hochstein	4,484,955	Nov. 27, 1984
Pearson	4,723,765	Feb. 9, 1988
Snaith et al. (Snaith)	5,149,066	Sep. 22, 1992

Claims 1, 2 and 11 to 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Snaith in view of Hochstein.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Snaith in view of Hochstein and Pearson.

Claims 9 and 14 to 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Snaith in view of Hochstein and Eshelman.

Claims 5 to 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eshelman in view of Hochstein.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 12, mailed August 3, 2001) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed June 14, 2001) and reply brief (Paper No. 13, filed October 9, 2001) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, to the appellant's declaration under 37 CFR § 1.132[1] (filed October 9, 2001 with the reply brief) and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence

[1] This declaration was entered and considered by the examiner. See Paper No. 16, mailed February 8, 2002.

adduced by the examiner is insufficient to establish a case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 3, 5 to 7, 9 and 11 to 17 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

All the rejections under appeal are based upon the examiner's determination that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have either (1) modified Snaith's isolator to have made the arched flexural support elements 44 from Nitinol based on Hochstein's teaching (column 2, lines 12-19) that Nitinol in the martensitic phase with a tensile yield strength in excess of 200,000 p.s.i. and an elastic modulus of about $4x10^6$ p.s.i. makes excellent springs, and in fact can store significantly more energy than steel because of the eight-fold

reduction in modulus of elasticity with no sacrifice in yield strength; or (2) modified the coil compression springs 3 of Eshelman's bumper system to be made from Nitinol based on the above-noted teaching of Hochstein.

In this case, when all the evidence before us is considered, we find ourselves in agreement with the appellants position as set forth in the brief and reply brief that the claimed subject matter is not suggested by the applied prior art. In that regard, we fail to find any reason in the teachings of the applied prior art why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified either Snaith or Eshelman to be an impact absorber having at least one Nitinol member disposed to bend in flexural mode and having high specific damping capacity of up to about 40%. In our view, applying Hochstein's teachings to either Snaith or Eshelman as set forth in the rejections under appeal would destroy the intended functioning of those devices. That is, the devices of Snaith and Eshelman would no longer act as a spring having a low damping capacity but would act as an impact absorber having a high specific damping capacity.

Since the subject matter of the claims under appeal is not suggested by the applied prior art when all the evidence before us is considered for the reasons set forth

above, the decision of the examiner to reject claims 1 to 3, 5 to 7, 9 and 11 to 17 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5 to 7, 9 and 11 to 17 under 35 U.S.C. § 103 is reversed.

REVERSED

LAWRENCE J. STAAB Administrative Patent Judge	)
JOHN P. McQUADE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)

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